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## Edwards & Angell LLP

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Date : November 12, 2003

<u>From : John B. Alexander, Ph.D.</u>	<u>Fax : (617) 439-4170</u>	<u>Direct : (617) 517-5555</u>
<u>To : Group 1600</u>		
<u>U.S. Trademark &amp; Patent Office</u>	<u>Fax : (703) 872-9306</u>	<u>Direct :</u>

Pages : 14

(including cover sheet)

If you received a partial delivery, please call Michelle P. Chicos at (617) 517-5551.

Re :

Enclosed please find a Reply to Non-Compliant Amendment in connection with U.S. Serial No. 09/666,152.

Please do not hesitate to contact me if you have any questions, or if I can be of any further assistance at this time.

Best Regards,

John B. Alexander, Ph.D.

JBA:mpc

# Fax

**Confidentiality Note :** The documents accompanying this facsimile contain information from the law firm of Edwards & Angell, L.L.P., which may be confidential and/or privileged. The information is intended for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this facsimile is strictly prohibited, and that the documents should be returned to this firm immediately. If you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the return of the original documents to us at no cost to you.

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PAGE 1/14 \* RCVD AT 11/12/2003 3:12:21 PM [Eastern Standard Time] \* SVR:USPTO-EFXRF-1/6 \* DNIS:8729306 \* CSID:617 439 4170 \* DURATION (mm-ss):03-24

NOV 12 2003

Practitioner's Docket No. 49218-C (71526)

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Shibuya et al.

SERIAL NO.: 09/666,152

EXAMINER: L. Stockton

FILED: September 20, 2000

GROUP: 1626

FOR: NOVEL AMIDE COMPOUNDS AND MEDICATIONS CONTAINING THE  
SAME

Mail Stop: No Fec Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

## AMENDMENT TRANSMITTAL

1. Transmitted herewith is a Request for Reconsideration for this application.

## STATUS

2. Applicant is  
[ ] a small entity. A statement:  
[ ] is attached.  
[ ] was already filed.  
[X] other than a small entity.

## EXTENSION OF TERM

NOTE: "Extension of Term in Patent Cases (Supplement Amendments) -- If a timely and complete response has been filed after a

## CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. SECTION 1.8(a))

I hereby certify that, on the date shown below, this correspondence is being:

## MAILING

- [ ] deposited with the United States Postal Service  
with sufficient postage as first class mail in an  
envelope addressed to the Commissioner for  
Patents, Alexandria, VA 22313-1450.

## FACSIMILE

- [X] transmitted by facsimile to the Patent and  
Trademark Office (703) 572-9306.

Date: November 12, 2003

Signature

Michelle P. ChicosMichelle P. Chicos

(type or print name of person certifying)

(Amendment Transmittal--page 1 of 4)

*Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.*

*If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run " Notice of December 10, 1985 (1061 O.G. 34-35).*

*NOTE: See 37 C.F.R. Section 1.645 for extensions of time in interference proceedings, and 37 C.F.R. Section 1.550(c) for extensions of time in reexamination proceedings.*

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. Section 1.136 apply.

*(complete (a) or (b), as applicable)*

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. Section 1.136 (fees: 37 C.F.R. Section 1.17(a)(1)-(4)) for the total number of months checked below:

	Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/>	one month	\$ 110.00	\$ 55.00
<input type="checkbox"/>	two months	\$ 400.00	\$ 200.00
<input type="checkbox"/>	three months	\$ 920.00	\$ 460.00
<input type="checkbox"/>	four months	\$ 1,440.00	\$ 720.00

Fee: \$ 0.00

If an additional extension of time is required, please consider this a petition therefor.

*(check and complete the next item, if applicable)*

- ☐ An extension for \_\_\_\_\_ months has already been secured. The fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ 0.00

OR

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

(Amendment Transmittal--page 2 of 4)

**FEE FOR CLAIMS**

4. The fee for claims (37 C.F.R. Section 1.16(b)-(d)) has been calculated as shown below

(Col.1)	(Col. 2)	SMALL ENTITY			OR	OTHER THAN A SMALL ENTITY	
Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Rate	Addit. Fee		Rate	Addit. Fee
			\$9.00	\$0.00		\$18.00	
Independent Claims			\$42.00	\$0.00		\$84.00	
First Presentation of Multiple Dependent Claim+			\$140.00	\$0.00		\$280.00	
						<b>Total Addit. Fee</b>	

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

\*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".

\*\*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".

The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

**WARNING:** "After final rejection or action (Section 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. Section 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

(c) ☐ No additional fee for claims is required.

OR

(d) ☐ Total additional fee for claims required \$ \_\_\_\_\_.

**FEE PAYMENT**

5. ☐ Attached is a check in the sum of \$ 0.00  
☐ Charge Account No. \_\_\_\_\_ the sum of \$ \_\_\_\_\_  
 A duplicate of this transmittal is attached.

(Amendment Transmittal--page 3 of 4)

**FEE DEFICIENCY**

*NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).*

6. ☒ If any additional extension and/or fee is required, charge Account No. 04-1105.

**AND/OR**

- ☒ If any additional fee for claims is required, charge Account No. 04-1105.

Date: November 12, 2003

  
SIGNATURE OF PRACTITIONER

John B. Alexander, Ph.D. (Reg. No. 48,399)  
(type or print name of practitioner)

EDWARDS & ANGELL, LLP  
Dike, Bronstein, Roberts & Cushman  
Intellectual Property Group  
P.O. Box 9169  
Boston, MA 02209  
Tel. No. (617) 439-4444

Customer No. 21874

BOS2\_354657.1

(Amendment Transmittal—page 4 of 4)

NOV 12 2003

Docket No. 49218-C (71526)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPLICANT:** Shibuya et al.  
**SERIAL NO.:** 09/666,152 **EXAMINER:** L. Stockton  
**FILED:** September 20, 2000 **GROUP:** 1626  
**FOR:** NOVEL AMIDE COMPOUNDS AND MEDICATIONS CONTAINING  
THE SAME

Mail Stop: Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REPLY TO NOTICE OF NON-COMPLIANT AMENDMENT

Sir:

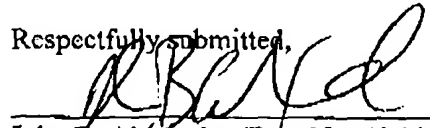
Applicants are in receipt of the Notice of Non-Compliant Amendment dated October 29, 2003. Enclosed is the entire "Amendments to the claims" section of the Amendment filed September 16, 2003 together with a Request for Continued Examination, in which the status of cancelled claim 13 was inadvertently omitted. The attached Amendments to the claims section properly lists claim 13 as cancelled.

Applicants believe that the prior response was a *bona fide* attempt to reply to the office action and further believe that the submission of the RCE together with the September 16, 2003 amendment removes the finality of the last action.

Although it is not believed that any additional fees are needed to consider this submission, the Examiner is hereby authorized to charge our deposit account no. 04-1105 should any fee be deemed necessary.

Respectfully submitted,

Date: November 12, 2003

  
John B. Alexander (Reg. No. 48,399)  
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P. O. Box 9169  
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Tel: (617) 439-4444  
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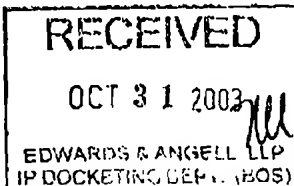
PFC/KCO/JBA 49218C (71526)



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1459  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,152	09/20/2000	Kunihiko Shibuya	49218-C	7703
21871	7590	10/29/2003		
EDWARDS & ANGELL, LLP P.O. BOX 9169 BOSTON, MA 02209				
			EXAMINER STOCKTON, LAURA LYNNE	
			ART UNIT 1626	PAPER NUMBER



DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

*amendment due*  
Edwards & Angeli LLP  
101 Federal St. Boston, MA 02110  
Docketed For *11/29/03 - 3/29/04*  
By *ME*  
Approved \_\_\_\_\_



## UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1480  
ALEXANDRIA, VA 22313-1480  
www.uspto.gov

Paper No.

## Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 10-20-03 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted. 37 CFR 1.121(h).

## THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_
- ☐ 3. Amendments to the drawings: \_\_\_\_\_
- ☐ 4. Amendments to the claims:
- ☒ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
  - ☐ D. The claims of the amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: Claim 13 wasn't presented as cancel.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/prenotice/officesflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION** (including a submission for an RCE), and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

Legal Instruments Examiner (LIE)

103/3084217  
Telephone No.

Rev. 10/03